

Kenneth A. Jones, et al.
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F7
cont.
--237. (Amended) The process of claim 231, wherein the cell
is an insect cell or a mammalian cell.--

add 10
A marked up copy of the amended claims is attached hereto as
Exhibit A.

REMARKS

Claims 190-249 are pending and under examination in the subject application. Claims 190-207, 209, 211, 212, 215-220, 226, 227, 232, and 241-249 were withdrawn from consideration by the Examiner as being directed to a non-elected subject matter. By this Amendment, applicants have canceled claims 190-207, 209, 211, 212, 215-220, 226, 227, 232, and 241-249 without prejudice or disclaimer, and amended claims 208, 210, 221, 224, 225, 228, 229, and 233-237. Accordingly, upon entry of this Amendment, claims 208, 210, 213, 214, 221-225, 228-231, and 233-240, as amended, will be pending and under examination.

Applicants maintain that the amendments to claims 208, 210, 221, 224, 225, 228, 229, and 233-237 raise no issue of new matter. Support for the amendments to claim 208, may be found inter alia in the specification as originally filed on page 52, lines 24-30. Support for the amendments to claim 224, may be found inter alia in the specification on page 57, line 13 through page 58, line 1. Claims 210, 221, 225, 228, 229, and 233-237 have been amended to correct their dependencies. Applicants respectfully request that the Amendment be entered.

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1. Rejection Under 35 U.S.C. 112, Second Paragraph

a. Claims 208 and 210

On page 3 of the July 10, 2001 Office Action, the Examiner rejected claims 208 and 210 under 35 U.S.C. §112, second paragraph, for allegedly being incomplete for omitting essential steps, such omission amounting to a gap between the steps. The Examiner pointed to MPEP § 2172.01. The Examiner alleged that the omitted step is: a step that determines whether or not the recited chemical compound is an agonist of GABA_BR1/R2 receptor. The Examiner stated that the claim requires the step of detecting an increase in activity of the GABA_BR1/R2 receptor "so as to thereby determine whether the compound is an agonist of a GABA_BR1/R2 receptor".

The Examiner suggested that replacing the phrase "so as to thereby determine whether the compound is an agonist of a GABA_BR1/R2 receptor" with the phrase "wherein said increase in activity indicates that the compound is an agonist of a GABA_BR1/R2 receptor" would obviate this rejection. Applicants thank the Examiner for his recommendation.

In an attempt to advance the prosecution of the subject application, but without conceding the correctness of the Examiner's position, applicants have amended claim 208. Amended claim 208 recites "wherein said increase in activity indicates that the compound is an agonist of a GABA_BR1/R2 receptor", as suggested by the Examiner. Claim 210 is directly dependent upon claim 208. Accordingly, applicants respectfully request that this ground of rejection be withdrawn.

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b. Claims 224, 225, and 228-230

On page 4 of the July 10, 2001 Office Action, the Examiner rejected claims 224, 225, and 228-230 under 35 U.S.C. §112, second paragraph, as indefinite for allegedly failing to particularly point out and distinctly claim the subject matter. The Examiner stated that the claims require that the artisan performing the method use a plurality of compounds "not known to activate a mammalian GABA_BR1/R2 receptor". The Examiner alleged that this phrase renders the metes and bounds of the claim unascertainable because it is not clear whom the claim requires to not have known, nor to what time frame this lack of knowledge is applicable, and further, the bounds of the claim will change with time and increases in knowledge.

In response, in an attempt to advance the prosecution of the subject application, but without conceding the correctness of the Examiner's position, applicants have amended claim 224 so that claim 224 no longer recites "not known to activate a mammalian GABA_BR1/R2 receptor". Claims 225 and 228-230 depend from claim 224. Applicants maintain that amended claim 224 particularly points out and distinctly claims the subject matter of the invention. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

2. Allowable Subject Matter

On page 4 of the July 10, 2001 Office Action, the Examiner indicated that claims 213, 214, 221-223, 231, and 233-240 are allowable. Applicants thank the Examiner for this indication of allowable subject matter.

In summary, in view of the amendments and remarks made hereinabove, applicants respectfully request that the Examiner

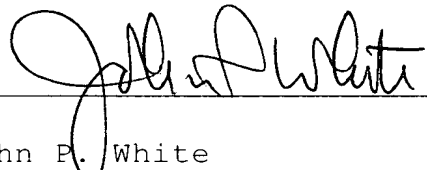
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reconsider and withdraw the rejections set forth in the July 10, 2001 Office Action and earnestly solicit allowance of all claims pending in the subject application, namely claims 208, 210, 213, 214, 221-225, 228-231, and 233-240.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

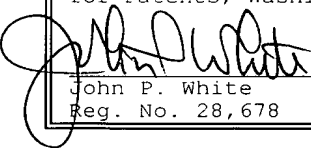
No fee is deemed necessary in connection with the filing of this Amendment. However, if a fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.



John P. White
Reg. No. 28,678

10/10/01
Date